

1772

EXPEDITED PROCEDURE
EXAMINING GROUP 1772
PATENT

#7
(N.S.)
5-2-03
JL



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN THE APPLICATION OF:

BARRY D. OLSON ET. AL.

CASE NO.: **CN0102 US NA**

APPLICATION NO.: **09/923,697**

CONFIRMATION NO.: **1564**

GROUP ART UNIT: **1772**

EXAMINER: **CATHERINE A. SIMONE**

FILED: **AUGUST 07, 2001**

FOR: **DECORATIVE MATERIALS HAVING GEOMETRIC PATTERNS AND
PROCESS FOR PREPARING THE SAME**

REQUEST FOR RECONSIDERATION

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

Reconsideration is respectfully requested of the final Office action dated February 24, 2003 setting forth a rejection of claims 1, 2 and 4 to 9 under the provisions of 35 USC 102(b) and claim 3 under the provisions of 35 USC 103(a). Claims 1 to 9 remain under consideration.

Initially, the courtesy of Catherine A. Simone, the Examiner in charge of the present patent application, is acknowledged in a telephone interview on April 22, 2003. During this interview, the undersigned stressed features of the present invention including criticality in the use of the wording "cross sections" in all claims under prosecution and the absence of formation of "cross sections" in Barnett USP 5,820,799 applied under the provisions of 35 USC 102 and 35 USC 103.

This request for reconsideration is divided into three main sections, namely:

- I. Office Position Misinterprets Scope of Claims.
- II. Office Position Misinterprets Teachings of Barnett U.S. Patent 5,820,799.
- III. Office Position Misinterprets Applicants' Arguments.

I. Office Position Misinterprets Scope of Claims

Claim 1, the sole independent claim under prosecution, in part (b) requires that "the visual appearance of the geometric patterns vary due to different cross sections of the geometric shape of (a) being exposed on the surface of the material". As will be more fully explained in Parts II and III of this request for reconsideration, applicants consider that

specific wording in the claims has not been given its ordinary meaning and, therefore, the scope of all claims has been misinterpreted in the Office communication. This wording is “different **cross sections** of the geometric shape...being exposed on the surface” (emphasis added). The terms “cross sections” and “different cross sections” are a significant requirement in applicants’ position of a patentable advance in the art. “Cross section” is employed in its normal meaning; illustratively The Random House Dictionary of the English Language, Unabridged Edition, Copyright 1996 provides the following:

“1. a section made by a plane cutting anything transversely, esp. at right angles to the longest axis. 2. A piece so cut off”.

Thus, it is a requirement in all claims that cross sections of the same geometric shape are present on a surface of the material. It is a requirement that the geometric shape be cross sectional to meet the requirement of the direct and clear language employed in independent claim 1 and all other claims under prosecution.

Although a process of manufacture is not under consideration, it is directly pointed out that in order to have cross sections of a geometric shape, it is necessary to cross section a geometric shape as evidenced by the above Random House Dictionary definition. Applicants do not rely on a method step in the present article claims under prosecution. However, inherently, it is necessary to perform cross sectioning to obtain “different cross sections” of a geometric shape.

In summary, it is respectfully submitted that the final Office position has not given a correct interpretation to the wording of “cross sections” and “different cross sections”.

II. Office Position Misinterprets Teachings of Barnett U.S. Patent 5,820,799

In the final rejection of claims 1, 2 and 4 to 9 under 35 USC 102(b) as anticipated by Barnett U.S. Patent 5,820,799 the Office action states:

“Barnett discloses a decorative material having geometric patterns on a surface... (b) wherein the visual appearance of the geometric patterns appear to vary due to different cross sections of a geometric shape being exposed on the surface of the material.”

In reply, applicants respectfully state that the above wording is incorrect. Barnett does not cross section and, therefore, cannot obtain cross sections being exposed on a surface of a material.

III. Office Position Misinterprets Applicants' Arguments

In paragraph 5 of the final Office action, reference has been initially made to applicants' arguments.

The following wording is present:

Applicant states that "Turning to the Barnett publication, it is admittedly true that, illustratively, a teaching of formation of swirls is present in the wording "produces the swirls found in cultured marbled materials." Applicant further states that "Barnett stands merely for a multitude of swirls being present, Barnett is not capable of forming different cross sections of the same swirl."

The final Office action responds to applicants' position with the following statement:

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "forming different cross sections of the same swirl") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

It is pointed out that the above wording is an incorrect response to applicants' position. Applicants directly state what Barnett discloses, namely, a teaching of formation of swirls. However, applicants again directly state that **Barnett is not capable of forming different cross sections of the same swirl**" (emphasis added).

Also, in response to the above wording from the final Office action, an incorrect statement is present that applicant is referencing "swirls" as a requirement such as in independent claim 1. Applicants require cross sections of a geometric shape.

To restate applicants position, it is necessary for a rejection under 35 USC 102 or 35 USC 103 that one of ordinary skill in the art derive an ability from Barnett or Barnett in combination with Takahashi et al. U.S. Patent 6,428,875 (for claim 3) of cross sectioning the same geometric shape. A mere allegation that it is possible to do so is incorrect. One of ordinary skill in the art must be able to derive a manner of formation of the final article.

Applicants' directly understand that the process of manufacture is not under consideration. However, the following is presented to demonstrate that definite cross sectioning step is applicable. Illustratively, the following is present in the body of the specification bridging pages 2 and 3:

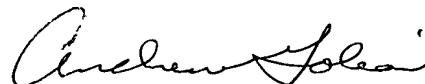
- (ii) combining the thermosettable molding compositions in a controlled fashion such that the individual molding compositions are discernable and create a three dimensional geometric shape,
- (iii) dividing the combined molding compositions into individual discrete portions in a manner that reveals cross sections of the geometric shape,
- (iv) combining the individual discrete portions containing cross sections of the geometric shape, and
- (v) fusing adjacent surfaces of individual discrete portions to form the decorative material having geometric patterns.

The above wording is not provided for reliance on method steps to provide patentability to claims 1 to 9. The above wording is provided that, in order to have "different cross sections", an enabling disclosure is provided in the present patent application. In contrast, any teaching and an enabling disclosure for obtaining a "cross section" is absent under the provisions of 35 USC 102 or 35 USC 103 based on Barnett or Barnett in combination with Takahashi et al.

In summary, applicants have provided three distinct sections in this request for reconsideration with a position that misinterpretation is present. Applicants respectfully request reconsideration in view of the statements made in this response.

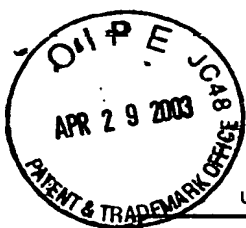
Withdrawal of all grounds of rejection is requested. A notice of allowance is solicited.

Respectfully submitted,



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Dated: April 24, 2003

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on April 24, 2003
Date

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M. KAY LILLY

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